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IN THE

Supreme Court of the United States

OCTOBER TERM 1965
No. 764

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF

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Respondent's brief emphasizes the vice inherent in the action taken by the Sixth Circuit Court of Appeals. In fact, if the procedures followed below are characteristic of "an ordinary patent infringement action"[1] no more cogent argument could be made for the need for exercise of this Court's supervisory authority to delineate the necessary criteria for a uniform judicial administration of the patent laws.

Respondent's statement relies heavily upon two purported "facts" which were uniquely "found" for the first time by the Court of Appeals and on which it relied in reaching its conclusion of invalidity for lack of "invention". One of these was an asserted concession[2] by petitioner that

[1]Respondent's Brief, p. 1.
[2]See Respondent's Brief, p. 2.

the "apparatus" was old and the other was an assertion that "the method of operation was not new".

To merely state the above shows the unreal state to which we have now come since, if such assertions are factually correct, both the apparatus and method claims of the patent in suit would clearly and unequivocally be invalid for lack of novelty under 35 U. S. C. § 102 and the defence of lack of "invention" would never need be reached. Apart from the questionable propriety of the appellate court's assumption of the trial court's fact finding responsibility, it is significant to note that the District Court below made no such findings of lack of novelty, nor did either the trial or appellate courts in the companion Farr Company case.[3] Quite to the contrary, the requisite novelty of the claimed subject matter was expressly found and accepted in the Farr case and there, as here, the sole issue was one of "invention"[4] and the standards determinative thereof. Likewise, the fact findings of the District Court below are singularly devoid of any such assertion of lack of novelty or even of facts from which such an assertion could be inferred.

As pointed out in the petition (p. 8), the Court of Appeals mentioned 35 U. S. C. § 103 only as a make-weight after having found the patent invalid by virtue of some undefined standard of invention embodied in § 101 of the statute. In so doing, however, it necessarily relied upon its own erroneous fact findings discussed above[5] and then compounded the error by erroneously asserting that the District Judge below and the Court of Appeals for the Ninth Circuit Court both *held* that the patent was invalid because of obviousness under § 103. The record, however, is expressly

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[3]See Petition p. 2-3.

[4]See Petition p. 3.

[5]Apparently on assumption that if the method and apparatus were old, they must have been known and hence were "obvious".

to the contrary. The District Court in the Farr case expressly found that the claimed subject matter was not obvious (See Findings 60, 22, 24; Appendix to Petition pp. 28a, 16a, 17a). The Ninth Circuit Court accepted the fact findings of the District Court[6], never considered or even mentioned the subject of obviousness and turned its decision on an asserted failure to meet a purported "standard of invention" which required the presence of "unusual or surprising consequences".[7] The District Court below, as a concomitant to its express adoption of the "ruling and reasoning" of the Ninth Circuit opinion "as the law of the case," adopted fact findings that are either quotes from or slightly paraphrased extracts of such opinion and nowhere therein is there any finding or statement that would show any consideration of the issue of obviousness by the trial court. (See Appendix to Petition, pp. 1a-5a)

Respondents brief emphasizes not only the negation of the statutory standards of patentability by the courts below, but also the inevitable performing of the fact finding function of the trial court by the appellate court that accompanies the same. In the case here presented we have a situation wherein the only trier of the facts who considered the case on the facts of record before him, *i.e.*, the District Court in the Farr case, found the patent valid and infringed and made detailed fact findings with respect thereto. The Ninth Circuit Court did not disturb these findings and reversed solely for lack of invention because of the purported lack of certain undefined but yet "requisite unusual or surprising consequences". The District Court below expressly adopted the Ninth Circuit opinion and found a set of facts in accordance with the wording of such opinion. The Sixth Circuit Court, in affirming, not only applied

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[6]See 318 F. 2d 500, 502.

[7]*Ibid* p. 502-3.

erroneous standards of invention but, in conjunction therewith, uniquely found as facts certain matters which were not only clearly erroneous but which were also contrary to the holdings and findings of every court which has previously considered this matter.

The petition in this action raises a question fundamental to the judicial administration of the patent laws which should be resolved by this Court.

Respectfully submitted,

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